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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM GABRIEL PAGAN

Appeal 2008-3865
Application 10/092,840
Technology Center 2100

Decided:¹ February 20, 2009

Before JAMES D. THOMAS, HOWARD B. BLANKENSHIP, and
STEPHEN C. SIU, *Administrative Patent Judges*.

BLANKENSHIP, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1-14, which are all the pending claims. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Invention

Appellant's invention relates to the field of graphical user interfaces and more particularly to the manipulation of multiple open document windows in a graphical user interface. (Spec. 1:4-6.)

Appellant's Figure 2 is reproduced
below:

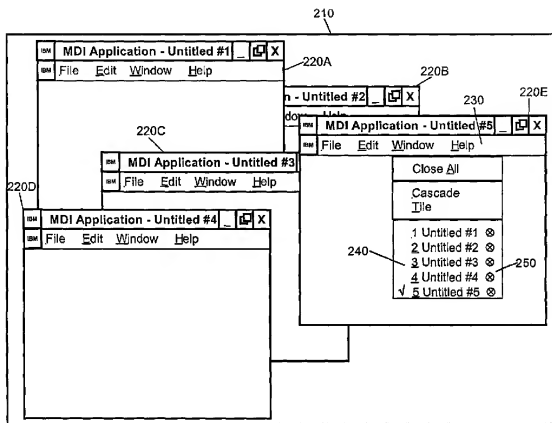


FIG. 2

Appellant's Figure 2 shows a menu listing 240 in open document window 220E. Each open document window listing in menu listing 240 can include a corresponding graphical user interface element 250, for example a button. Each interactive graphical user interface element 250 can trigger a pre-defined window manipulation operation, such as a window close operation. (Spec. 7:19 - 8:9.)

Representative Claim

1. A method for manipulating multiple open document windows through a pull-down menu of an activated open document window comprising the steps of:

creating a pull-down menu in the activated open document window comprising a listing of open document windows and corresponding interactive user interface elements; and,

responsive to the activation of one of said interactive user interface elements, performing a pre-defined window manipulation operation, separate from a focus change operation, upon an inactive open document window corresponding to said activated interactive user interface element.

Prior Art

The Examiner relies on the following reference as evidence of unpatentability.

Beaudet	5,491,795	Feb. 13, 1996
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Examiner's Rejections

Claims 1, 4, and 7 stand rejected under 35 U.S.C. § 112, first paragraph, as based on a disclosure which is not enabling.

Claims 1-14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Appellant's Admitted Prior Art (APA), described in the Specification at pages 2 through 3 and depicted in Figure 1, and Beaudet.

ISSUES

(1) Has the Examiner sustained the initial burden in showing that the Specification fails to enable the subject matter of claims 1, 4, and 7?

(2) Has Appellant shown that claim 1 has been rejected over the applied prior art in error?

PRINCIPLES OF LAW -- ENABLEMENT

“Although the statute does not say so, enablement requires that the specification teach those in the art to make and use the invention without ‘undue experimentation.’ That some experimentation may be required is not fatal; the issue is whether the amount of experimentation required is ‘undue.’” *In re Vaeck*, 947 F.2d 488, 495 (Fed. Cir. 1991) (citations omitted).

“Whether undue experimentation is needed is not a single, simple factual determination, but rather is a conclusion reached by weighing many factual considerations.” *In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988). The factors to be considered in determining whether a disclosure would require undue experimentation include:

(1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims.

Id.

The examiner bears the initial burden of setting forth a reasonable explanation as to why the scope of protection provided by the claims is

thought to be not adequately enabled by the description of the invention provided in the specification. If that burden is met, the burden then shifts to the applicant to provide proof that the specification is indeed enabling. *In re Wright*, 999 F.2d 1557, 1561-62 (Fed. Cir. 1993).

Claims which failed to recite the use of a cooling zone, specially located, which the specification taught as essential, were not supported by an enabling disclosure. *In re Mayhew*, 527 F.2d 1229, 1233 (CCPA 1976).

ANALYSIS -- ENABLEMENT

“Performing a pre-defined window manipulation operation, separate from a focus change operation, upon an inactive document window, which is critical to the practice of the invention, is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).” (Ans. 3.)

The Examiner’s rejection would have been helped, perhaps, had the Examiner provided us with a clear indication of the ordinary artisan’s understanding of the term “focus change operation.” We cannot say, in view of this record, the extent of operations that might be within the meaning of a “focus change operation.” Appellant has provided information that shows there were operations in the prior art, applied in the Examiner’s § 103 rejection, that fall within the meaning of “a pre-defined window manipulation operation, separate from a focus change operation, upon an inactive document window” as recited in instant claim 1. We can say, therefore, that the “separate from a focus change operation” recitation is met by the applied prior art (*infra*). We cannot say what other subject matter might fall within the recitation of “separate from a focus change operation.”

The Examiner's reference to *In re Mayhew* suggests there is some element missing from claims 1, 4, and 7 that the Specification teaches as being essential to practice of the invention.² Presumably, the Specification is deemed to teach that a "pre-defined window manipulation operation" in combination with, or as part of, a "focus change operation" applied to an "inactive document window" is critical to the practice of the invention. Since we do not know the extent of what a "focus change operation" might entail, we would be forced to speculate as to whether the Specification teaches that the combined operation is essential to the invention, or that the "pre-defined window manipulation operation" is something not "separate from a focus change operation."

In our estimation, the rejection for lack of enablement is not sufficiently developed on this record. We conclude that the Examiner has not met the initial burden of setting forth a reasonable explanation as to why the scope of protection provided by the claims is thought to be not adequately enabled by the description of the invention provided in the Specification. We do not sustain the rejection of claims 1, 4, and 7 under 35 U.S.C. § 112, first paragraph.

² In view of the Examiner's indication that "all claims dependent on claims 1, 4, and 7 are similarly rejected" (Ans. 3), we conclude that the alleged missing element is not in any of the dependent claims. If the dependent claims are rejected for lack of enabling disclosure, the claims should have been included in the initial list of claims in the statement of the § 112 rejection.

FINDINGS OF FACT -- PRIOR ART

Admitted Prior Art

Appellant's Figure 1 is reproduced below:

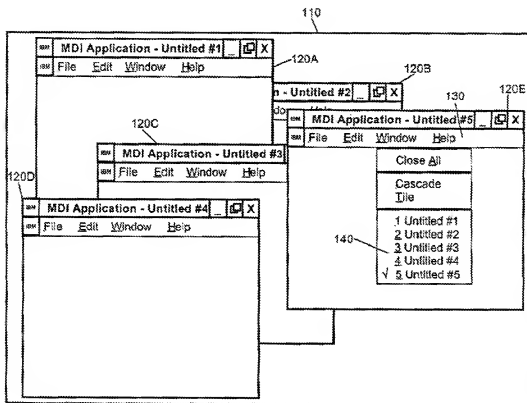


FIG. 1 (Prior Art)

Figure 1 of Appellant's disclosure shows a multiple document interface (MDI) screen having open document windows 120A, 120B, 120C, 120D, and 120E. A window list 140, available from menu bar 130, can provide a list of all the open document windows. (*See Spec. 1:7 - 3:9.*)

To close each document window 120A, 120B, 120C, 120D, and 120E required that each window be selected and closed individually. (Spec. 3:9-11.)

As apparent to one skilled in the art, the process of selecting and closing the windows individually can be inefficient and burdensome. (Spec. 3:11-12.)

However, some applications (as shown in Fig. 1) provide for a window or file “Close All” operation. (Spec. 2:15-17.) Figure 1 also depicts, below the “Close All” selection, the selections of “Cascade” and “Tile,” which also correspond to window manipulation operations.

Beaudet

Beaudet's Figure 2 is reproduced below:

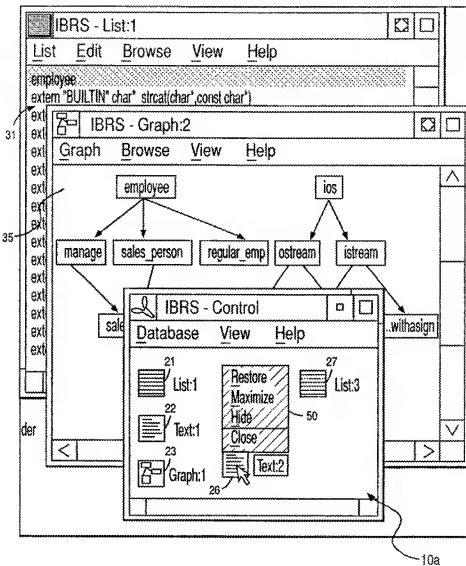


FIG. 2

Figure 2 of Beaudet shows a graphical user interface having a pop-up window 50 in control window 10a. The pop-up window 50 is responsive to

single-clicking a mouse over an icon (e.g., icon 21, corresponding to open window List:1). Figure 2 depicts selection of icon 26, representative of an active but hidden window (“Text:2,” corresponding to window Text:2, not shown). Beaudet col. 3, ll. 37-47; col. 4, ll. 15-23, 46-57.

The user may select operations that control the selected window (e.g., window Text:2), such as restore, maximize, hide, and close. Beaudet col. 5, ll. 46-57; col. 7, ll. 14-49; Fig. 7.

PRINCIPLES OF LAW -- OBVIOUSNESS

A person having ordinary skill in the art uses known elements for their intended purpose. *Anderson’s-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57 (1969) (radiant-heat burner used for its intended purpose in combination with a spreader and a tamper and screed).

“[W]hen a patent ‘simply arranges old elements with each performing the same function it had been known to perform’ and yields no more than one would expect from such an arrangement, the combination is obvious.” *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1740 (2007) (quoting *Sakraida v. Ag Pro, Inc.*, 425 U.S. 273, 282 (1976)).

ANALYSIS -- OBVIOUSNESS

Because Appellant does not rely on the limitations of any particular claim, we will decide the appeal with respect to the § 103 rejection on the basis of claim 1 alone. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Although Appellant fails to rely on the limitations of any particular claim on appeal, the Appeal Brief contains a heading (at 11) alleging that the

applied prior art, even if combined, would not result in the “claimed invention.” However, Appellant neglects to tell us what part of the “claimed invention” might be thought missing from the applied combination.

Appellant’s “Prior Art” Figure 1 shows creating a pull-down menu (that includes window list 140) in the activated open document window (120E) comprising a listing of open document windows (140) and corresponding interactive user interface elements (Close All, Cascade, and Tile). Responsive to the activation of one of the interactive user interface elements (any of Close All, Cascade, and Tile), a pre-defined window manipulation operation is performed (i.e., the windows are closed, cascaded, or tiled). The pre-defined window manipulation operation is performed upon an inactive open document window (e.g., 120D, which is closed with other windows, cascaded with other windows, or tiled with other windows), corresponding to the activated interactive user interface element.

The only claim 1 element that might appear to be missing from Appellant’s Prior Art figure is that the pre-defined window manipulation operation is “separate from a focus change operation.” However, a “focus change operation,” according to Appellant, refers to the “focus” of the operating system changing from one window to another. (Reply Br. 2 n.1.) The operating system “focus” may relate to Beaudet’s description of a “focus area” that receives subsequent keyboard input. Beaudet col. 3, ll. 66-67.

The claim 1 “separate from a focus change operation” language does not appear to distinguish over the APA “Cascade” or “Tile” selections, because the operating system focus would remain on the active window

(120E). The claim 1 “separate from a focus change operation” appears, initially, to distinguish over the Prior Art Figure 1 “Close All” selection, because the operating system focus would turn to each window, in turn, as the windows are closed. However, Appellant’s disclosed improvement (e.g., interactive user interface elements 250; Fig. 2) for closing an individual window (Spec. 8:5-9) appears to be within the meaning of “without a focus change operation,” in view of Appellant’s remarks at page 4 of the Appeal Brief concerning how the Specification teaches performing a window manipulation operation “without a focus change operation” -- i.e., manipulating an open document window *without requiring activation* of the open document window.

Thus, it appears that even the “Close All” operation shown in Prior Art Figure 1 is within the meaning of “without a focus change operation,” as the closing of the windows occurs without activation of a selected open document. In other words, selected open documents can be manipulated through another open document window “without requiring activation of the selected open document window.” (Spec. 7:10-11.)

In yet another definition for “focus change operation,” Appellant submits that “[a] focus change operation and the activation of an open document window are one and the same.” (Reply Br. 3.) Prior Art Figure 1 also meets that definition as it relates to “separate from a focus change operation,” since the Cascade, Tile, or Close All operation would not activate open document windows different from active window 120E.

Appellant’s alleged improvement over the prior art appears to be for providing the facility to manipulate “selected” open document windows “in

a centralized and convenient manner.” (Spec. 2:18-20.) Instant claim 1, however, does not distinguish over a pre-defined window manipulation operation that affects *more than one* inactive open document window, as depicted in Prior Art Figure 1.

Absent Appellant’s help in submitting *some* limitation that may be absent from the applied prior art (or even from the “Prior Art”), we turn to the arguments that Appellant has submitted in support of patentability.

Appellant argues that the rejection has failed to establish “a realistic motivation to combine,” and that the rejection has failed in properly “identifying the teachings of Beaudet.” (App. Br. 5-11.)

As we have indicated in the Findings of Fact section, Beaudet teaches operations directed to a selected window, such as restore, maximize, hide, and close, from another, active window. Each of the hide and close operations directed to a selected window, at the least, would be “separate from a focus change operation,” by any of the definitions of “focus change operation” that Appellant has provided.

“[I]f a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.” *KSR*, 127 S. Ct. at 1740. The operative question in this “functional approach” is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.*

Applying Beaudet’s single-window operations to the prior art represented by Appellant’s Figure 1 appears to be no more than the

predictable use of prior art elements according to their established functions, and thus obvious to one of ordinary skill in the art. In any event, Appellant has provided no evidence to show that effecting such a combination was “uniquely challenging or difficult for one of ordinary skill in the art.” See *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007) (citing *KSR*, 127 S. Ct. at 1741).

We disagree that the Examiner has failed to “properly identify” the teachings of Beaudet. “The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain.” *In re Heck*, 699 F.2d 1331, 1333 (Fed. Cir. 1983) (quoting *In re Lemelson*, 397 F.2d 1006, 1009 (CCPA 1968)).

We are also not persuaded by Appellant’s allegations that, in effect, propose the rhetorical question: if the “modification” of the prior art was so obvious, then why did not Beaudet arrive at the claimed invention? The short answer to Appellant’s argument is that Beaudet is not alleged to anticipate the claimed invention. Other sections of Title 35 of the U.S. Code, separate from § 102, may also forbid issuance of a patent -- see, for example, § 103.

Under the heading in the Appeal Brief that indicates that the applied prior art, if combined, would not result in the claimed invention, Appellant submits that “since Beaudet advocates a separate control window 10,” the reference “teaches away” from the claimed invention. (App. Br. 13.)

“A reference may be said to teach away when a person of ordinary skill, upon [examining] the reference, would be discouraged from following

the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.” *Para-Ordnance Mfg., Inc. v. SGS Importers Int’l, Inc.* 73 F.3d 1085, 1090 (Fed. Cir. 1995) (quoting *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994)).

Although Beaudet uses a “separate control window” in the invention, Appellant has not identified any warning to the artisan that a “separate control window” is required for controlling operations with respect to inactive windows. We are therefore not persuaded that Beaudet “teaches away.”

Thus, although Beaudet appears to be merely cumulative in its teachings in view of instant claim 1 and the Admitted Prior Art, we find no error in applying the teachings of Beaudet to the Admitted Prior Art as contemplated by the Examiner’s rejection.

We are therefore not persuaded that claim 1 has been rejected in error. We sustain the § 103 rejection of claim 1. The remaining claims (2-14) fall with claim 1.

CONCLUSIONS OF LAW

(1) The Examiner has not sustained the initial burden in showing that the Specification fails to enable the subject matter of claims 1, 4, and 7.

(2) Appellant has not shown that claim 1 has been rejected over the applied prior art in error.

DECISION

The rejection of claims 1, 4, and 7 under 35 U.S.C. § 112, first paragraph, as based on a disclosure which is not enabling, is reversed.

The rejection of claims 1-14 under 35 U.S.C. § 103(a) as being unpatentable over APA and Beaudet is affirmed.

Because we have sustained at least one ground of rejection against each claim on appeal, the Examiner's decision is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

msc

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